

ADV0001-US



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

EBERHARD SCHMID ET AL.

Serial No.: 10/520,527

Filed: OCTOBER 11, 2005

For: ALLOY, ESPECIALLY FOR
SPECTACLE FRAMES

Art Unit: 1742

Examiner: Not Yet Assigned

REQUEST FOR CORRECTED FILING RECEIPT

Office of Initial Patent Examination
Customer Service Center
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

A corrected Official Filing Receipt is hereby requested in view of the error that appears in the original. For the convenience of the Patent and Trademark Office, attached is a photocopy of the original receipt on which the requested correction has been noted in red.

If any fees are necessary to act upon this request, the Patent Office is authorized to charge Deposit Account No. 03-3975.

Serial No.: 10/520,527
Art Unit: 1742
Inventor: Eberhard SCHMID et al.

Attorney's Docket No.: ADV0001-US
Page 2

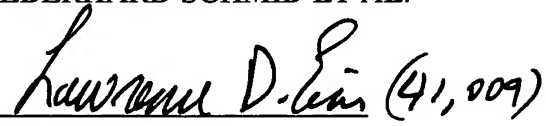
PILLSBURY WINTHROP SHAW PITTMAN LLP
1650 Tysons Boulevard
McLean, VA 22102
Tel: 703/770-7900

Respectfully submitted,

EBERHARD SCHMID ET AL.

Date: March 13, 2006

By:

 (41,009)
Michael Bednarek
Registration No. 32,329

Attachment: Marked Up Copy of Filing Receipt

MB/LDE/ggb

Customer No. 00909



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
 United States Patent and Trademark Office
 Address: COMMISSIONER FOR PATENTS
 P.O. Box 1450
 Alexandria, Virginia 22313-1450
 www.uspto.gov

APPL NO.	FILING OR 371 (c) DATE	ART UNIT	FIL FEE REC'D	ATTY. DOCKET NO	DRAWINGS	TOT CLMS	IND CLMS
10/520,527	10/11/2005	1742	1030	ADV0001-US	2 3	10	1

CONFIRMATION NO. 9242

28970
 PILLSBURY WINTHROP SHAW PITTMAN LLP
 1650 TYSONS BOULEVARD
 MCLEAN, VA 22102

FILING RECEIPT



OC000000017842702

Date Mailed: 01/25/2006

Receipt is acknowledged of this regular Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please mail to the Commissioner for Patents P.O. Box 1450 Alexandria Va 22313-1450. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).

Applicant(s)

Eberhard Schmid, Alzenau, GERMANY;
 Thomas Himmighofen, Giessen, GERMANY;
 Josef Breiter, Wetztenberg, GERMANY;
 Juergen Schlottner, Woelfersheim, GERMANY;
 Bernd Dietrich, Herborn, GERMANY;

Power of Attorney:

Michael Bednarek-32329

Domestic Priority data as claimed by applicant

This application is a 371 of PCT/EP03/07458 07/10/2003

Foreign Applications

GERMANY 202 11 557.7 07/12/2002

Projected Publication Date: To Be Determined - pending completion of Security Review

Non-Publication Request: No

Early Publication Request: No

Title

Alloy, especially for spectacle frames

Preliminary Class

148

PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES

Since the rights granted by a U.S. patent extend only throughout the territory of the United States and have no effect in a foreign country, an inventor who wishes patent protection in another country must apply for a patent in a specific country or in regional patent offices. Applicants may wish to consider the filing of an international application under the Patent Cooperation Treaty (PCT). An international (PCT) application generally has the same effect as a regular national patent application in each PCT-member country. The PCT process **simplifies** the filing of patent applications on the same invention in member countries, but **does not result** in a grant of "an international patent" and does not eliminate the need of applicants to file additional documents and fees in countries where patent protection is desired.

Almost every country has its own patent law, and a person desiring a patent in a particular country must make an application for patent in that country in accordance with its particular laws. Since the laws of many countries differ in various respects from the patent law of the United States, applicants are advised to seek guidance from specific foreign countries to ensure that patent rights are not lost prematurely.

Applicants also are advised that in the case of inventions made in the United States, the Director of the USPTO must issue a license before applicants can apply for a patent in a foreign country. The filing of a U.S. patent application serves as a request for a foreign filing license. The application's filing receipt contains further information and guidance as to the status of applicant's license for foreign filing.

Applicants may wish to consult the USPTO booklet, "General Information Concerning Patents" (specifically, the section entitled "Treaties and Foreign Patents") for more information on timeframes and deadlines for filing foreign patent applications. The guide is available either by contacting the USPTO Contact Center at 800-786-9199, or it can be viewed on the USPTO website at <http://www.uspto.gov/web/offices/pac/doc/general/index.html>.

For information on preventing theft of your intellectual property (patents, trademarks and copyrights), you may wish to consult the U.S. Government website, <http://www.stopfakes.gov>. Part of a Department of Commerce initiative, this website includes self-help "toolkits" giving innovators guidance on how to protect intellectual property in specific countries such as China, Korea and Mexico. For questions regarding patent enforcement issues, applicants may call the U.S. Government hotline at 1-866-999-HALT (1-866-999-4158).

**LICENSE FOR FOREIGN FILING UNDER
Title 35, United States Code, Section 184
Title 37, Code of Federal Regulations, 5.11 & 5.15**

GRANTED

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof

unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Bureau of Industry and Security, Department of Commerce (15 CFR parts 730-774); the Office of Foreign Assets Control, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

NOT GRANTED

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15(b).

Translation

PATENT COOPERATION TREATY

PCT/EP2003/007458



PCT

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

(PCT Article 36 and Rule 70)

Applicant's or agent's file reference BER-046-WO	FOR FURTHER ACTION See Notification of Transmittal of International Preliminary Examination Report (Form PCT/IPEA/416)	
International application No. PCT/EP2003/007458	International filing date (day/month/year) 10 July 2003 (10.07.2003)	Priority date (day/month/year) 12 July 2002 (12.07.2002)
International Patent Classification (IPC) or national classification and IPC C22C 9/02		
Applicant BERKENHOFF GMBH		

1. This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.

2. This REPORT consists of a total of 5 sheets, including this cover sheet.

☒ This report is also accompanied by ANNEXES, i.e., sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT).

These annexes consist of a total of 2 sheets.

3. This report contains indications relating to the following items:

- I ☒ Basis of the report
- II ☐ Priority
- III ☐ Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- IV ☐ Lack of unity of invention
- V ☒ Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- VI ☐ Certain documents cited
- VII ☐ Certain defects in the international application
- VIII ☐ Certain observations on the international application

Date of submission of the demand 16 December 2003 (16.12.2003)	Date of completion of this report 29 October 2004 (29.10.2004)
Name and mailing address of the IPEA/EP	Authorized officer
Facsimile No.	Telephone No.

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.

PCT/EP2003/007458

I. Basis of the report

1. With regard to the elements of the international application:*

- ☐ the international application as originally filed
- ☒ the description:
pages _____ 1-6 _____, as originally filed
pages _____, filed with the demand
pages _____, filed with the letter of _____
- ☒ the claims:
pages _____, as originally filed
pages _____, as amended (together with any statement under Article 19
pages _____, filed with the demand
pages _____ 1-6 _____, filed with the letter of _____ 12 October 2004 (12.10.2004)
- ☒ the drawings:
pages _____ 1/3-3/3 _____, as originally filed
pages _____, filed with the demand
pages _____, filed with the letter of _____
- ☐ the sequence listing part of the description:
pages _____, as originally filed
pages _____, filed with the demand
pages _____, filed with the letter of _____

2. With regard to the language, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.

These elements were available or furnished to this Authority in the following language _____ which is:

- ☐ the language of a translation furnished for the purposes of international search (under Rule 23.1(b)).
- ☐ the language of publication of the international application (under Rule 48.3(b)).
- ☐ the language of the translation furnished for the purposes of international preliminary examination (under Rule 55.2 and/or 55.3).

3. With regard to any nucleotide and/or amino acid sequence disclosed in the international application, the international preliminary examination was carried out on the basis of the sequence listing:

- ☐ contained in the international application in written form.
- ☐ filed together with the international application in computer readable form.
- ☐ furnished subsequently to this Authority in written form.
- ☐ furnished subsequently to this Authority in computer readable form.
- ☐ The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.
- ☐ The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

4. ☐ The amendments have resulted in the cancellation of:

- ☐ the description, pages _____
- ☐ the claims, Nos. _____
- ☐ the drawings, sheets/fig _____

5. ☐ This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).**

* Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report since they do not contain amendments (Rule 70.16 and 70.17).

** Any replacement sheet containing such amendments must be referred to under item 1 and annexed to this report.

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.

PCT/EP 03/07458

V. Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Claims		YES
	Claims	1-6	NO
Inventive step (IS)	Claims		YES
	Claims	1-6	NO
Industrial applicability (IA)	Claims	1-6	YES
	Claims		NO

2. Citations and explanations

1. Novelty, PCT Article 33(2)

1.1. D1 (cf. page 2, lines 60-66, page 3, lines 4 and 9-27; claims 1, 6 and 7) describes an alloy for use in the field of jewelry, clothing accessories, spectacles and spectacle parts, consisting of: 4-12% Sn, 0.1-4% Fe, and optionally up to 10% Mn and/or Zn, 0.01-0.5% P, copper residue and the usual impurities.

The alloy composition and its purpose in D1 overlap with the alloy disclosed in claim 1 of the present application and its purpose, and therefore the subject matter of claim 1 lacks novelty (PCT Article 33(2)).

The additional features of claim 2 are likewise known from D1 and therefore lack novelty.

Claims 3-6 are directed to products made using the alloy according to claim 1. These products are also known from D1. Consequently, claims 3-6 likewise lack novelty.

1.2. A line of reasoning similar to that in point 1.1 also applies to D2 (cf. claims 1, 6 and 7), which describes an alloy for use in the field of jewelry, clothing accessories, spectacles and spectacle parts, consisting

of: 12-20% Sn, 0.1-4% Fe, and optionally up to 5% Mn and/or Zn, 0.01-0.5% P, copper residue and the usual impurities.

2. Inventive step, PCT Article 33(3)

2.1. The teaching according to D1, which is regarded as the closest prior art, differs in formal terms from the claimed alloy according to claim 1 in that the elements Zn, Mn and P are obligatory, whereas in D1 they are merely optional. A person skilled in the art will always consider these elements when the aim is for the alloy to be produced in a cost-effective manner and have sufficient strength (cf. D1, page 3, lines 24-25 and 15-16).

Even if the subject matter of claim 1 were regarded as novel, it would not be regarded as involving an inventive step. Therefore, the subject matter of claim 1 does not satisfy the criterion stipulated in PCT Article 33(3).

3. Additional observations

The resilience characteristic is a use feature inherent to every alloy used for spectacle frames (see also D1, page 2, lines 47-48).

Furthermore, a selection ranging from 1-8% Zn in the present application cannot be regarded as a narrow selection with respect to D1.